Docket No. RSW920010209US1 (7161-025U) **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
John S. COX, et al	:	Confirmation Number: 1002
Application No.: 10/026,384	:	Group Art Unit: 2857
Filed: December 21, 2001	:	Examiner: H. Wachsman

For: SCENARIO BASED TESTING AND LOAD GENERATION FOR WEB APPLICATIONS

APPEAL BRIEF

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Commissioner for Patents
P.O. Box 1450
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Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed March 19, 2007, wherein Appellant appeals from the Examiner's rejection of claims 2-15.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on December 21, 2001, at Reel 012408, Frame 0474.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-15 are pending in this Application. Claim 1 has been allowed, claims 2-15 have been three-times rejected. It is from the multiple rejections of claims 2-15 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Third Office Action dated December 19, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figure 2 and to independent claims 2 and 9 a Web application testing method is disclosed. In step 208, session data in an intercepted network message is identified and state information for said session in the Web application is retrieved (page 12, lines 1-7 of Appellants' disclosure). In steps 210, 212, an operation and associated operational parameters is selected from a Web scenario template based upon said retrieved state information (page 12, lines 6-7). In step 214, an operation is invoked in the Web application, as selected from said Web scenario template, in lieu of invoking an operation in the Web application based upon said intercepted network message (page 12, lines 22-23).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 2-15 were rejected under 35 U.S.C. § 101.

VII. ARGUMENT

THE REJECTION OF CLAIMS 2-15 UNDER 35 U.S.C. § 101

For convenience of the Honorable Board in addressing the rejections, and claims 2-8 stand or fall together with independent claim 1, and claims 10-15 stand or fall together with independent claim 9.

The Examiner's statement of the rejection with regard to claims 2-15 is found in the paragraph spanning pages 2 and 3 of the Third Office Action, which is reproduced below:

> Claims 2-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention does not transform an article or physical object to a different state or thing (note: transformation of data is not "physical transformation") and does not produce a "useful, concrete and tangible result". For example, in claim 2 the final result is "invoking said operation in the Web application as selected from said Web scenario template in lieu of invoking an operation in the Web application based upon said intercepted network message". However, it is not clear in the claim that this result is being conveyed to someone or something such that the usefulness of the invoking of the operation of the Web application could be realized, and that such an operation represents a specific, substantial and credible utility.

At the outset, Appellants note that the Examiner has applied an improper standard with regard to the requirement enunciated in State Street Bank & Trust Co. V. Signature Financial Group, Inc.[1] that the claimed invention produces a "useful, concrete, and tangible result." Absent from State Street Bank is a requirement that the claims themselves recite the useful, concrete, and tangible result. Instead, as noted in M.P.E.P. § 2106 (IV)(C)(2)

> USPTO personnel shall review the claim to determine it produces a useful, tangible, and concrete result. In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is "useful, tangible, and concrete."

Reference is also made to the second paragraph of 35 U.S.C. § 112, which is reproduced below:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[1] 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1999).

The second paragraph of 35 U.S.C. § 112 sets forth the requirements for the claims, yet absent from this paragraph is a requirement that the claims themselves recite a useful, concrete, and tangible result or any requirements associated with satisfying 35 U.S.C. § 101.

Claims 1-8

Independent claim 1 is directed to a method and, thus, clearly falls within the classes of statutory subject matter described by 35 U.S.C. § 101. However, the Examiner asserts "it is not clear in the claim that this result is being conveyed to someone or something such that the usefulness of the invoking of the operation of the Web application could be realized." Although issued prior the State Street Bank decision, the reference is made to U.S. Patent No. 5,333,184 (hereinafter the '184 patent). Claim 1 of the '184 patent is reproduced below:

> 1. A method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber, said method comprising the steps of:
>
> generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and
>
> including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers.

Upon reviewing this claim, it is readily apparent that the Examiner could argue that "it is not clear in the claim that this result is being conveyed to someone or something such that the usefulness of the message record having a PIC indicator could be realized." Thus, if the Examiner's analysis in the present Office Action was followed at the time the application, which

matured into the '184 patent, was examined, then this claim would have been rejected under 35 U.S.C. § 101.

Appellants have referred to the '184 patent because this patent was the subject of the decision by the Federal Circuit in AT&T Corp. v. Excel Communications, Inc.[2] The conclusion of the Federal Circuit with regard to the '184 patent is "we find that the claimed subject matter is properly within the statutory scope of 101." Thus, the Examiner's analysis that the claim is not clear as to whether or not the usefulness of the invoking of the operation of the Web application could be realized is not supported by the decision of the Federal Circuit that the claimed subject matter recited in the '184 patent is directed to statutory subject matter.

Claims 9-15

Independent claim 9 is directed to machine readable storage and, thus, clearly falls within the classes of statutory subject matter described by 35 U.S.C. § 101 since storage is a device. In particular, Appellants note that claim 9 is directed to a machine readable storage upon which is stored a computer program for performing a particular method. This claim is commonly referred to as a Beauregard claim based upon the decision of the Federal Circuit in In re Beauregard.[3] Thus, the claimed invention, as recited in claim 9, is directed to statutory subject matter.

Appellants note the Examiner's question in the third enumerated paragraph in which the Examiner stated "preambles of claims 9-15 refer to a 'machine readable storage' however was this intended to be a 'machine readable storage medium' or a 'machine readable storage apparatus'

[2] 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999).
[3] 53 F.3d 1583, 35 USPQ2d 1383 (Fed. Cir. 1995).

for example?" In response, Appellants note that the answer to this question is that it does not matter. Both a machine readable storage medium (e.g., a USB key, a computer disk) and a machine readable storage apparatus (e.g., a memory, a hard drive) are tangible devices.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejection under 35 U.S.C. § 101 is not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 101.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: March 19, 2007

Respectfully submitted,

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VIII. CLAIMS APPENDIX

2. A Web application testing method comprising the steps of:

identifying session data in an intercepted network message and retrieving state information for said session in the Web application ;

selecting an operation and associated operational parameters from a Web scenario template based upon said retrieved state information; and,

invoking said operation in the Web application as selected from said Web scenario template in lieu of invoking an operation in the Web application based upon said intercepted network message.

3. The method of claim 2, further comprising the steps of:

intercepting a network response to said invoked operations;

retrieving new state information for the Web application corresponding to said session in the Web application; and,

repeating said selecting and invoking steps for said new state information regardless of said network response.

4. The method of claim 2, further comprising the step of intercepting a hypertext transfer protocol (HTTP) formatted network message in a load driving servlet communicatively linked to the Web application and remotely positioned from a client transmitting said HTTP formatted network message.

5. The method of claim 2, wherein said invoking step comprises the step of executing a dispatch-include servlet operation based upon said selected operation and associated operational parameters.

6. The method of claim 3, further comprising the step of logging application performance data during the Web application testing.

7. The method of claim 2, wherein said selecting comprises the steps of:

selecting one of a set of Web scenario templates; and,

further selecting from within said selected Web scenario template, an operation and associated operational parameters based upon said retrieved state information.

8. The method of claim 7, wherein said step of selecting one of a set of Web scenario templates comprises the steps of:

establishing a mixing percentage for each one of said Web scenario templates, said mixing percentage specifying a frequency for which said Web scenario template will be selected; and,

selecting said one of said set of Web scenario templates according to said established mixing percentage for said one of said set of Web scenario templates.

9. A machine readable storage having stored thereon a computer program for Web application testing, said computer program comprising a routine set of instructions which when executed by the machine cause the machine to perform the steps of:

identifying session data in an intercepted network message and retrieving state information for said session in the Web application ;

selecting an operation and associated operational parameters from a Web scenario template based upon said retrieved state information; and,

invoking said operation in the Web application as selected from said Web scenario template in lieu of invoking an operation in the Web application based upon said intercepted network message.

10. The machine readable storage of claim 9, further comprising the steps of:

intercepting a network response to said invoked operations;

retrieving new state information for the Web application corresponding to said session in the Web application; and,

repeating said selecting and invoking steps for said new state information regardless of said network response.

11. The machine readable storage of claim 9, further comprising the step of intercepting a hypertext transfer protocol (HTTP) formatted network message in a load driving servlet communicatively linked to the Web application and remotely positioned from a client transmitting said HTTP formatted network message.

12. The machine readable storage of claim 9, wherein said invoking step comprises the step of executing a dispatch-include servlet operation based upon said selected operation and associated operational parameters.

13. The machine readable storage of claim 10, further comprising the step of logging application performance data during the Web application testing.

14. The machine readable storage of claim 9, wherein said selecting comprises the steps of:

selecting one of a set of Web scenario templates; and,

further selecting from within said selected Web scenario template, an operation and associated operational parameters based upon said retrieved state information.

15. The machine readable storage of claim 14, wherein said step of selecting one of a set of Web scenario templates comprises the steps of:

establishing a mixing percentage for each one of said Web scenario templates, said mixing percentage specifying a frequency for which said Web scenario template will be selected; and,

selecting said one of said set of Web scenario templates according to said established mixing percentage for said one of said set of Web scenario templates.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.